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MAL, KEVIN S				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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# Office Action Summary

**Application No.**

10/654,960

**Applicant(s)**

ENAMI ET AL.

**Examiner**

KEVIN S. MAI

**Art Unit**

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-30 is/are rejected.  
7) ☒ Claim(s) 1, 26 and 27 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/21/04, 2/2/04, 9/1/04, 10/5/04, 12/13/04, 2/2/05, 6/1/07, 8/3/07  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_



**DETAILED ACTION**

1. Claims 1-30 have been examined and are pending.

***Claim Objections***

2. Claims 1, 26 and 27 are objected to because of the following informalities:
3. Claim 1 is objected to because it recites “are connected each other”. It appears that it should have recited “are connected **to** each other”.
4. Claim 26 is objected to because it recites “received said other image forming apparatus relating each other”. It appears that it should have recited “received **from** said other image forming apparatus relating **to** each other”.
5. Claim 27 is objected to because it recites “is said transfer request satisfies”. It appears that it should have recited “**if** said transfer request satisfied”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 28 and 29 recite the limitations “said transfer request”, “said destination”, and “said user terminal”. These limitations are first introduced in claim 27.

8. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 appears to be reciting that the stored document was received from the user terminal. However, claim 26 does not appear to claim the stored document being from the user terminal that is first disclosed in claim 27.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 21 claims a computer program. Thus claim 21 is only claiming software which is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 2, 10-12, 20, 21, 23 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 7130069 to Honma (hereinafter “Honma”).

13. **As to Claim 1**, Honma discloses **a file transfer system, comprising:**

**a file management server** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP');

**a file transmitting terminal** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL data into a personal box of an image-forming apparatus named 'general affairs section GP'); **and**

**a file receiving terminal** (Column 15 lines 25-30 of Honma disclose a user retrieving the original document data from the personal box of the 'general affairs section GP' image-forming apparatus and printing it out on another image-forming apparatus names 'sales section 1 GP');  
**wherein**

**said file management server, said file transmitting terminal, and said file receiving terminal are connected each other via a network** (Column 15 lines 33-36 of Honma disclose the two image-forming apparatuses being in communication with each other. Then since column 15 lines 7-10 disclose the host computer transferring data to the image-forming apparatus, the host computer is also seen to be connected);

**said file transmitting terminal transmits to said file management server a file and a corresponding authorization condition for accessing said file** (Column 12 lines 45-56 of Honma disclose a user being able to enter a PDL document into their own or somebody else's personal box by transmitting the image data to the image-forming apparatus. Then it is disclosed in column 15 lines 39-45 that any time a personal box is accessed a password needs to be input.

Thus it is seen that choosing a personal box to enter a file into is setting an authorization condition for that file);

**said file management server stores said file and said corresponding authorization condition transmitted from said file transmitting terminal** (Column 15 lines 7-10 of Honma disclose a host computer transfers PDL data into a personal box of an image-forming apparatus. Thus it is seen that the file is stored as well as the condition to access it);

**said file receiving terminal transmits to said file management server a request for transferring said file** (Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes requesting); **and**

**said file management server, in response to said request transmitted by said file receiving terminal, if said corresponding authorization condition stored therein is satisfied, transfers the file to said file receiving terminal** (Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected. Thus it is seen that in order to access the files a password must be entered, and thus requests are not taken until this is satisfied).

14. **As to Claim 2**, Honma discloses the invention as claimed as described in claim 1, **wherein**

**said authorization condition corresponding to said file is a password for accessing said file** (Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose

documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected); **and**

**said file management server, if a password transmitted with said request by said file receiving terminal matches said password transmitted by said file transmitting terminal, transmits said file to said file receiving terminal** (Column 21 lines 55-62 of Honma disclose a user looking into the personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted).

15. **As to Claim 10**, Honma discloses the invention as claimed as described in claim 1, **wherein said file receiving terminal prints or stores, in a recording medium, said file received from said file management server** (Column 15 lines 25-30 of Honma disclose a user retrieving the original document data from the personal box of the 'general affairs section GP' image-forming apparatus and printing it out on another image-forming apparatus names 'sales section 1 GP').

16. **As to Claim 11**, Honma discloses **a file management server connected to a file transmitting terminal and a file receiving terminal via a network, comprising:**



**a communication unit that exchanges data with an external apparatus via said network** (Column 4 lines 46-51 of Honma disclose the image-forming apparatus containing a network interface to serve as an interface between external apparatuses);

**a first storage unit that stores a file and an authorization condition for accessing said file related each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords); **and**

**a file transferring unit that, in response to a request for transferring said file stored in said first storage unit from said file receiving terminal, if said authorization condition is satisfied, transfers said file to said file receiving terminal** (Column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted).

17. **As to Claim 12**, Honma discloses the invention as claimed as described in claim 11, **wherein**

**said authorization condition corresponding to said file is a password for accessing said file** (Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected); **and**

**said file transferring unit, if a password transmitted with said request matches said password stored in said first storage unit, transfers said file to said file receiving terminal** (Column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted).

18. **As to Claim 20**, Honma discloses a **file transfer method, comprising the steps of: receiving a file and an authorization condition for accessing said file transmitted by a file transmitting terminal** (Column 12 lines 45-56 of Honma disclose a user being able to enter a PDL document into their own or somebody else's personal box by transmitting the image data to the image-forming apparatus. Then it is disclosed in column 15 lines 39-45 that any time a personal box is accessed a password needs to be input. Thus it is seen that choosing a personal box to enter a file into is setting an authorization condition for that file); **storing said file and said authorization condition transmitted by said file transfer terminal** (Column 15 lines 7-10 of Honma disclose a host computer transfers PDL data into a personal box of an image-forming apparatus. Thus it is seen that the file is stored as well as the condition to access it); **receiving a request for transmitting said file designated from a file receiving terminal** (Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the

'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes requesting);

**determining, in response to said request, whether said authorization condition is satisfied**

(Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected. Thus it is seen that in order to access the files a password must be entered, and thus requests are not taken until this is satisfied); **and**

**transmitting, if said authorization condition is satisfied, said file to said file receiving**

**terminal** (Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes having the file transmitted).

19. **As to Claim 21**, Honma discloses **a computer program that causes a computer to perform the steps of** (Column 2 lines 55-56 of Honma disclose a computer-readable storage medium storing a software program):

**receiving a file and an authorization condition for accessing said file transmitted by a file**

**transmitting terminal** (Column 12 lines 45-56 of Honma disclose a user being able to enter a PDL document into their own or somebody else's personal box by transmitting the image data to the image-forming apparatus. Then it is disclosed in column 15 lines 39-45 that any time a personal box is accessed a password needs to be input. Thus it is seen that choosing a personal box to enter a file into is setting an authorization condition for that file);

**storing said file and said authorization condition transmitted by said file transfer terminal**

(Column 15 lines 7-10 of Honma disclose a host computer transfers PDL data into a personal box of an image-forming apparatus. Thus it is seen that the file is stored as well as the condition to access it);

**receiving a request for transmitting said file designated from a file receiving terminal**

(Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes requesting);

**determining, in response to said request, whether said authorization condition is satisfied**

(Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected. Thus it is seen that in order to access the files a password must be entered, and thus requests are not taken until this is satisfied); **and**

**transmitting, if said authorization condition is satisfied, said file to said file receiving**

**terminal** (Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes having the file transmitted).

20. **As to Claim 23**, Honma discloses a stored document management server connected to a first image forming apparatus and a second image forming apparatus via a network, comprising:

**a communication unit that exchanges data with said first and second image forming apparatuses via said network** (Column 4 lines 46-51 of Honma disclose the image-forming apparatus containing a network interface to serve as an interface between external apparatuses); **a first storage unit that stores a stored document and an authorization condition for accessing said stored document related each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords); **and**

**a stored document transferring unit that, in response to a request for transferring said stored document stored in said first storage unit from a second image forming apparatus, if said authorization condition is satisfied, transfers said stored document to said image forming apparatus** (Column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted).

21. **As to Claim 26, Honma discloses an image forming apparatus connected with another image forming apparatus via a network, comprising:**

**a communication unit that exchanges data via said network** (Column 4 lines 46-51 of Honma disclose the image-forming apparatus containing a network interface to serve as an interface between external apparatuses);

**a storage unit that stores a stored document and an authorization condition for accessing said stored document received said other image forming apparatus relating each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords);

**an operations input unit** (Figure 1 of Honma discloses a disk drive unit with a file section);

**an image forming unit that, in response to reception of a request for printing said stored document, if said authorization condition for accessing said stored document is satisfied, prints said stored document** (Column 15 lines 60-68 disclose a user sending in a request and password to print a document and then the image forming apparatus begins printing).

*Claim Rejections - 35 USC § 103*

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 22, 24, 25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma.

24. **As to Claim 22**, Honma discloses **an image forming system, comprising:**

**a stored document management server** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP');

**a first image forming apparatus that stores a stored document** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP'); **and**

**a second image forming apparatus** (Column 15 lines 25-30 of Honma disclose a user retrieving the original document data from the personal box of the 'general affairs section GP' image-forming apparatus and printing it out on another image-forming apparatus names 'sales section 1 GP');

**wherein**

**said stored document management server, said first image forming apparatus, and said second image forming apparatus are connected each other via a network** (Column 2 lines 13-15 of Honma discloses the system includes a plurality of image-forming apparatuses containing network communication units);

**said first image forming apparatus transmits to said stored document management server said stored document and an authorization condition for accessing said stored document**

(Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords. Figure 1 also discloses that the image-forming apparatuses all contain a network interface. Since each image-forming apparatus of the plurality of the image-forming apparatuses contains the storage space with personal boxes

and the ability to communicate with other image forming apparatuses. It is seen that it would have been obvious to have one image-forming apparatus transmit a stored document to another image forming apparatus to hold. Such functionality would be beneficial in terms of managing space on any given image-forming apparatus);

**said file management server stores the transmitted stored document and the transmitted authorization condition relating each other** (Column 15 lines 7-10 of Honma disclose a host computer transfers PDL data into a personal box of an image-forming apparatus. Thus it is seen that the file is stored as well as the condition to access it. As disclosed above it is seen that it would have been obvious for another image forming apparatus to be the host sending the PDL data);

**said second image forming apparatus transmits to said stored document management server a request for transferring the stored document** (Column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes requesting);  
**and**

**said stored document management server, in response to said request transmitted by said second image forming apparatus, if the stored authorization condition is satisfied, transfers the stored document to said second image forming apparatus** (Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected. Thus it is seen that in order to access the files a password must be entered, and thus requests are not taken until this is satisfied).



25. **As to Claim 24**, Honma discloses **an image forming system, comprising:**

**a first image forming apparatus** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP');

**a user terminal** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL data into a personal box of an image-forming apparatus named 'general affairs section GP'); **and**

**a second image forming apparatus** (Column 15 lines 25-30 of Honma disclose a user retrieving the original document data from the personal box of the 'general affairs section GP' image-forming apparatus and printing it out on another image-forming apparatus names 'sales section 1 GP');

**wherein**

**said first image forming apparatus, said user terminal, and said second image forming apparatus are connected each other via a network** (Column 15 lines 33-36 of Honma disclose the two image-forming apparatuses being in communication with each other. Then since column 15 lines 7-10 disclose the host computer transferring data to the image-forming apparatus, the host computer is also seen to be connected);

**said first image forming apparatus stores a stored document and an authorization condition for accessing said stored document relating each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords) **and, in response to a request from said user**

**terminal, if said authorization condition is satisfied, transmits said stored document and said authorization condition to said second image forming apparatus** (Column 14 lines 22-30 of Honma disclose the PC selecting between two options, namely allowing the image-forming apparatus to immediately print the image data or to store in the hard disk in the image-forming apparatus rather than immediately printing. Thus in view of the user being able to issue print commands from his PC it would be obvious to give the user the ability to issue the command to print the document at another image-forming apparatus. Such functionality would make the system more convenient to the user. As to the data being transmitted, column 21 lines 55-62 of Honma disclose the user using the image-forming apparatus of the 'sales section 1 GP' to retrieve the image data from the 'general affairs section GP'. The action of retrieving includes having the file get transmitted); **and**

**said second image forming apparatus stores said stored document and said authorization condition relating each other and, if said authorization condition is satisfied, prints said stored document** (Column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted).

26. **As to Claim 25, Honma discloses an image forming system, comprising:**

**a first image forming apparatus** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP');

**a stored document management server** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL (Page Description Language) data into a personal box of an image-forming apparatus named 'general affairs section GP');

**a user terminal** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL data into a personal box of an image-forming apparatus named 'general affairs section GP'); **and**  
**a second image forming apparatus** (Column 15 lines 25-30 of Honma disclose a user retrieving the original document data from the personal box of the 'general affairs section GP' image-forming apparatus and printing it out on another image-forming apparatus names 'sales section 1 GP');

**wherein**

**said first image forming apparatus, said stored document management server, said user terminal, and said second image forming apparatus are connected each other via a network** (Column 2 lines 13-15 of Honma discloses the system includes a plurality of image-forming apparatuses containing network communication units. Then since column 15 lines 7-10 disclose the host computer transferring data to the image-forming apparatus, the host computer is also seen to be connected);

**said first image forming apparatus stores a stored document and an authorization condition for accessing said stored document relating each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how

files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords) **and, in response to a request from said user terminal, if said authorization condition is satisfied, transmits said stored document and said authorization condition to said stored document management server** (Column 14 lines 22-30 of Honma disclose the PC selecting between two options, namely allowing the image-forming apparatus to immediately print the image data or to store in the hard disk in the image-forming apparatus rather than immediately printing. Thus in view of the user being able to issue store commands from his PC it would be obvious to give the user the ability to issue the command to store the document at another image-forming apparatus. Such functionality would make the system more convenient to the user. As to it being transmitted to a management server, Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords. Figure 1 also discloses that the image-forming apparatuses all contain a network interface. Since each image-forming apparatus of the plurality of the image-forming apparatuses contains the storage space with personal boxes and the ability to communicate with other image forming apparatuses. It is seen that it would have been obvious to have one image-forming apparatus transmit a stored document to another image forming apparatus to hold. Such functionality would be beneficial in terms of managing space on any given image-forming apparatus);

**said stored document management server stores said stored document and said authorization condition transmitted from said first image forming apparatus relating each other** (Column 15 lines 7-10 of Honma disclose a host computer transfers PDL data into a

personal box of an image-forming apparatus. Thus it is seen that the file is stored as well as the condition to access it. As disclosed above it is seen that it would have been obvious for another image forming apparatus to be the host sending the PDL data) **and, in response to a request for transmitting said stored document from said second image forming apparatus, if said authorization condition for accessing said stored document is satisfied, transmits said stored document to said second image forming apparatus** (Column 20 lines 48-56 of Honma disclose that when selecting a personal box to choose documents from, a password screen is presented. The password is checked against the password stored in the memory for the personal box selected. Thus it is seen that in order to access the files a password must be entered, and thus requests are not taken until this is satisfied); **and** **said second image forming apparatus prints said stored document transmitted from said stored document management server** (Column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP').

27. **As to Claim 27**, Honma discloses the invention as claimed as described in claim 26, **wherein** **said image forming apparatus is further connected to a user terminal via said network** (Column 15 lines 7-10 of Honma disclose a host computer transferring data to the image-forming apparatus, a host computer is also seen to be connected); **and**

**said communication unit, in response to a transfer request from said user terminal, is said transfer request satisfies said authorization condition, transmits said stored document and said authorization condition stored in said storage unit to a destination** (Column 14 lines 22-30 of Honma disclose the PC selecting between two options, namely allowing the image-forming apparatus to immediately print the image data or to store in the hard disk in the image-forming apparatus rather than immediately printing. Thus in view of the user being able to issue store commands from his PC it would be obvious to give the user the ability to issue the command to store the document at another image-forming apparatus).

28. **As to Claim 28**, Honma discloses the invention as claimed as described in claim 26, **wherein said transfer request includes said destination** (Column 12 lines 45-56 disclose a user selecting which personal box to transmit a file to), **a password as said authorization information for accessing said stored document** (Column 21 lines 29-30 of Honma disclose entering a password in the process of getting a document), **and a registration code of said stored document** (Column 21 lines 35-38 of Honma disclose selecting a desired document) **that said communication unit has received from said user terminal via said network** (Thus it is seen that in order to transfer a file, all the information above would need to be present and as such it would have been obvious for a transfer request to contain all the above information).

29. **As to Claim 29**, Honma discloses the invention as claimed as described in claim 26, **wherein said transfer request includes said destination** (Column 12 lines 45-56 disclose a user selecting which personal box to transmit a file to), **said authorization condition for**

**accessing said stored document** (Column 21 lines 29-30 of Honma disclose entering a password in the process of getting a document), **and a registration code of said stored document** (Column 21 lines 35-38 of Honma disclose selecting a desired document) **that are input by said operations input unit** (Thus it is seen that in order to transfer a file, all the information above would need to be present and as such it would have been obvious for a transfer request to contain all the above information).

30. **As to Claim 30**, Honma discloses **an image forming apparatus connected with a stored document management server and a user terminal via a network, comprising: a communication unit that exchanges data via said network** (Column 4 lines 46-51 of Honma disclose the image-forming apparatus containing a network interface to serve as an interface between external apparatuses); **a storage unit that stores a stored document and an authorization condition for accessing said stored document relating each other** (Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords); **and an image forming unit that prints said stored document** (Column 15 lines 60-68 disclose a user sending in a request and password to print a document and then the image forming apparatus begins printing); **wherein**

**said communication unit, in response to reception of a request for transmitting said stored document from said user terminal, if said request satisfies said authorization condition stored in said storage unit, transmits said stored document and said authorization condition to said stored document management server** (Column 14 lines 22-30 of Honma disclose the PC selecting between two options, namely allowing the image-forming apparatus to immediately print the image data or to store in the hard disk in the image-forming apparatus rather than immediately printing. Thus in view of the user being able to issue store commands from his PC it would be obvious to give the user the ability to issue the command to store the document at another image-forming apparatus. Such functionality would make the system more convenient to the user. As to it being transmitted to a management server, Figure 1 of Honma discloses a disk drive unit with a file section. Then in column 12 lines 25-37 it is disclosed how files are stored into personal boxes on the image-forming apparatus and the personal boxes are known to be associated with passwords. Figure 1 also discloses that the image-forming apparatuses all contain a network interface. Since each image-forming apparatus of the plurality of the image-forming apparatuses contains the storage space with personal boxes and the ability to communicate with other image forming apparatuses. It is seen that it would have been obvious to have one image-forming apparatus transmit a stored document to another image forming apparatus to hold. Such functionality would be beneficial in terms of managing space on any given image-forming apparatus).



31. Claims 3, 5, 6-8, 13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma and further in view of US Pat. No. 6785812 to Botham, Jr. et al. (hereinafter "Botham").

32. **As to Claim 3**, Honma discloses the invention as claimed as described in claim 1. Honma does not explicitly disclose **wherein said authorization condition is one or more user IDs that are authorized to access said file; and said file management server, if a user ID transmitted with said request by said file receiving terminal is included in said one or more user IDs transmitted by said file transmitting terminal, transmits said file to said file receiving terminal.**

However, Botham discloses this (Column 3 lines 60-65 of Botham disclose comparing a received client ID against the stored client ID to see if the client is entitled to receive the requested document. Then column 3 lines 65-67 disclose upon validating the request the server retrieves the requested document)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the system of claim 1 as disclosed by Honma, with using user ID as an authorization condition as disclosed by Botham. One of ordinary skill in the art would have been motivated to combine to make document distribution more secure and controllable (column 2 lines 18-65).

33. **As to Claim 5**, Honma discloses the invention as claimed as described in claim 1. Honma does not explicitly disclose **wherein**

**said file transmitting terminal transmits an effective period corresponding to said file;  
said file management server stores the corresponding effective period with said file; and  
said file management server, if the corresponding effective period has expires, prohibits  
said file from being transmitted.**

However, Botham discloses this (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only “live” for a specified amount of time. Then column 21 lines 55-62 of Honma disclose a user looking into a personal box on the ‘general affairs section GP’ using the imaging-forming apparatus of the ‘sales section 1 GP’. Then Honma discloses printing out the image data on the ‘sales section 1 GP’. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted. Thus it is seen that it would have been obvious to replace the password condition with the time period condition).

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the system of claim 1 as disclosed by Honma, with having a time expiration period as disclosed by Botham. One of ordinary skill in the art would have been motivated to combine to make document distribution more secure and controllable (column 2 lines 18-65).

34. **As to Claim 6**, Honma-Botham discloses the invention as claimed as described in claim 5, **wherein said file management server, if the corresponding effective period has expired, deletes said file** (Column 4 lines 34-36 of Botham discloses destroying a document once it's allotted lifetime has expired).

Examiner recites the same rationale to combine used in claim 5.

35. **As to Claim 7**, Honma discloses the invention as claimed as described in claim 1.

Honma does not explicitly disclose **wherein**

**said file transmitting terminal transmits an effective number of transfers corresponding to said file;**

**said file management server stores the corresponding effective number of transfers with said file; and**

**said file management server, if the number of transfers of said file reaches the corresponding effective number of transfers, prohibits said file from being transmitted.**

However, Botham discloses this (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only be viewed or printed a maximum number of times. Then based on purpose of setting a maximum number of times a document may be printed it is inherent that when a file reaches the effective number, it will no longer be distributed)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the system of claim 1 as disclosed by Honma, with having a maximum number of times a document may be printed as disclosed by Botham. One of ordinary skill in the art would have been motivated to combine to make document distribution more secure and controllable (column 2 lines 18-65).

36. **As to Claim 8**, Honma-Botham discloses the invention as claimed as described in claim 7, wherein said file management server, if the number of transfers of said file reaches the corresponding effective number of transfers, deletes said file (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only be viewed or printed a maximum number of times. Thus it is seen that when a document has been viewed/printed the maximum number of times it is essentially no longer accessible, thus it would be obvious to delete the document in order to preserve space on the file management server).

37. **As to Claim 13**, Honma discloses the invention as claimed as described in claim 11. Honma does not explicitly disclose wherein said authorization condition corresponding to said file is one or more user IDs; and said file transferring unit, if a user ID transmitted with said request is included in said one or more user IDs stored in said first storage unit, transfers said file to said file receiving terminal.

However, Botham discloses this (Column 3 lines 60-65 of Botham disclose comparing a received client ID against the stored client ID to see if the client is entitled to receive the requested document. Then column 3 lines 65-67 disclose upon validating the request the server retrieves the requested document)

Examiner recites the same rationale to combine used in claim 3.

38. **As to Claim 15**, Honma discloses the invention as claimed as described in claim 11.

Honma does not explicitly disclose **wherein**

**said first storage unit further stores the effective period of said file; and**

**said file transfer unit, if the effective period of said file has expired, avoids transferring said file to said file receiving terminal.**

However, Botham discloses this (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only “live” for a specified amount of time. Then column 21 lines 55-62 of Honma disclose a user looking into a personal box on the ‘general affairs section GP’ using the imaging-forming apparatus of the ‘sales section 1 GP’. Then Honma discloses printing out the image data on the ‘sales section 1 GP’. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted. Thus it is seen that it would have been obvious to replace the password condition with the time period condition).

Examiner recites the same rationale to combine used in claim 5.

39. **As to Claim 16**, Honma-Botham discloses the invention as claimed as described in claim 15, **wherein said file transferring unit, if the effective period of said file has expired, deletes said file** (Column 4 lines 34-36 of Botham discloses destroying a document once its allotted lifetime has expired).

Examiner recites the same rationale to combine used in claim 5.

40. **As to Claim 17**, Honma discloses the invention as claimed as described in claim 11.

Honma does not explicitly disclose **wherein**

**said first storage unit further stores the effective number of transfers of said file; and  
said file transfer unit, if the number of transfers of said file reaches the effective number  
stored in said first storage unit, avoids transferring said file to said file receiving terminal.**

However, Botham discloses this (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only be viewed or printed a maximum number of times. Then based on purpose of setting a maximum number of times a document may be printed it is inherent that when a file reaches the effective number, it will no longer be distributed)

Examiner recites the same rationale to combine used in claim 7.

41. **As to Claim 18**, Honma-Botham discloses the invention as claimed as described in claim 17, **wherein said file transferring unit, if the number of transfers of said file reaches the effective number, deletes said file** (Column 2 lines 45-55 of Botham disclose being able define control characteristics, including allowing a document to only be viewed or printed a maximum number of times. Thus it is seen that when a document has been viewed/printed the maximum number of times it is essentially no longer accessible, thus it would be obvious to delete the document in order to preserve space on the file management server).

42. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Honma and further in view of US Pat. No. 6233618 to Shannon (hereinafter "Shannon").

43. **As to Claim 4**, Honma discloses the invention as claimed as described in claim 1.

Honma does not explicitly disclose **wherein**

**said authorization condition is the membership of a group that is authorized to access said file; and**

**said file management server, if a user ID transmitted with said request by said file receiving terminal is a member of said group, transmits said file to said file receiving terminal.**

However, Shannon discloses this (Column 7 lines 58-68 of Shannon disclose a user of a particular group being restricted from viewing particular pages. Then column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted. Thus it is seen that it would have been obvious to replace the password condition with the user being part of a group condition)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the system of claim 1 as disclosed by Honma, with using membership of a group as the authorization condition as disclosed by Shannon. One of ordinary skill in the art would have been motivated to combine to improve access and control capabilities (column 3 lines 35-45 of Shannon).

44. **As to Claim 14**, Honma discloses the invention as claimed as described in claim 11.

Honma does not explicitly disclose **further comprising a second storage unit that stores group name and user IDs of group members;**

**wherein**

**said authorization condition stored in said first storage unit is said group name; and  
said file transferring unit, if a user ID transmitted with said request is included in said group members, transfers said file to said file receiving terminal.**

However, Shannon discloses this (Column 7 Table 1 discloses a storage associating Clients with their groups. Then column 7 lines 58-68 of Shannon disclose a user of a particular group being restricted from viewing particular pages. Then column 21 lines 55-62 of Honma disclose a user looking into a personal box on the 'general affairs section GP' using the imaging-forming apparatus of the 'sales section 1 GP'. Then Honma discloses printing out the image data on the 'sales section 1 GP'. To have accessed the personal box to print the document a password must have been entered (column 20 lines 48-56) thus it is seen that after verifying the password the document is transmitted. Thus it is seen that it would have been obvious to replace the password condition with the user being part of a group condition)

Examiner recites the same rationale to combine used in claim 4.

45. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma and further in view of US Pub. No. 2002/0174010 to Rice, III (hereinafter "Rice").



46. **As to Claim 9**, Honma discloses the invention as claimed as described in claim 1, **further comprising a user terminal connected to said file management server via said network** (Column 15 lines 7-10 of Honma disclose a host computer transferring PDL data into a personal box of an image-forming apparatus named 'general affairs section GP'); Honma does not explicitly disclose **wherein said user terminal acquires the address of said file receiving terminal and transmits the address to said file management server; said file management server stores the address of said file receiving terminal transmitted from said user terminal and; and said file management server, in response to said request for transmitting said file from said file receiving terminal, if the address of said file receiving terminal match the stored address.**

However, Rice discloses this (Paragraph [0110] of Rice discloses an AppLink which is a link to a data files that may specify recipient permissions and other access parameters. Then in paragraph [0178] it is disclose that a particular recipient could be restricted to accessing the AppLink from a particular IP address. Thus it is seen that a recipient is restricted access to a file based on their IP address. Paragraph [0179] discloses that the sender is the one who sets restrictions and access to the files)

It would have been obvious to one of ordinary skill in the art at the time of invention to combine system of claim 1 as disclosed by Honma, with restricting access by IP address as disclosed by Rice. One of ordinary skill in the art would have been motivated to combine to improve data security (paragraph [0104] of Rice).

47. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Honma-Shannon and further in view of Rice.

48. **As to Claim 19**, Honma-Shannon discloses the invention as claimed as described in claim 14. Honma-Shannon does not explicitly disclose **wherein said second storage unit stores the address of said file receiving terminal transmitted from a user terminal, and said file transferring unit, in response to a request for transferring said file, said request transmitted from said file receiving terminal, only if the address of said file receiving terminal matches the address stored in said first storage unit, transmits said file to said file receiving terminal.**

However, Rice discloses this (Paragraph [0110] of Rice discloses an AppLink which is a link to a data files that may specify recipient permissions and other access parameters. Then in paragraph [0178] it is disclose that a particular recipient could be restricted to accessing the AppLink from a particular IP address. Thus it is seen that a recipient is restricted access to a file based on their IP address. Paragraph [0179] discloses that the sender is the one who sets restrictions and access to the files. As to the address being stored, it would have been obvious to have the address being stored somewhere, otherwise it would not be accessible)

Examiner recites the same rationale to combine used in claim 9.

*Conclusion*

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5835922 A - Document processing apparatus and method for inputting the requirements of a reader or writer and for processing documents according to the requirements to Shima; Yoshihiro et al.

US 6914687 B1 - Data processing apparatus and image recording apparatus, method for controlling data processing apparatus and method for controlling image recording apparatus, and storage medium to Hosoda; Yuichi et al.

US 20030076526 A1 - Method and apparatus for printing documents using a document repository in a distributed data processing system to Gopalan, Prabhakar

US 6931432 B1 - Data transmission apparatus and method with control feature for transmitting data or transmitting a storage location of data to Yoshida; Hiroyoshi

US 7190475 B2 - Method for providing a print and apparatus to Nomoto; Tetsushi

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN S. MAI whose telephone number is (571)270-5001. The examiner can normally be reached on Monday through Friday 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2100

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KSM

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151